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10/577,240

04/26/2006

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EXAMINER

KRUPICKA, ADAM C

ART UNIT

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1794

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/577,240 | Applicant(s) HERMONY ET AL. | |
| | Examiner Adam C. Krupicka | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-13 and 16-23 is/are rejected.
- 7) ☒ Claim(s) 6-8, 14 and 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/26/2006 and 07/12/2007</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation “the second surface of the second film is coated with a release layer” has previously been recited in parent claim 1.

Claims 6, 7, 8, 14 and 15 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 9-13, and 17-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

One or more of the claims recite the limitations “the first surface”, “the second surface”, “the packaging substrate”, “the desired tamper-evident message”, “the area” or “the margins”.

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There is insufficient antecedent basis for these limitations in these claims. Regarding claims 1, 2, 3, 5, 9, 16, 17, 20 and 23, it is unclear whether applicant intends the first layer to be positioned over or under the second layer, and whether the upper or lower surfaces are considered to be the first or second surfaces. Also, what packaging substrate is being referred to in claim 4? Further, claim 23 refers to “the margins” where no parent claim has been drawn to a margin, and where the examiner does not consider a tape or sheet to inherently have margins. Additionally, regarding “the desired tamper-evident message”, it is unclear to what message applicant is referring in claims 18, 19, 21, and 22, and finally regarding “the area” as set forth by claim 2 it is unclear to what area applicant is referring, since applicant is claiming more than one area (considered to refer back to "certain areas").

Claims 3, 17, 20, and 22 are drawn to “certain areas” however the phrase is considered to be vague and indefinite as no structure or definition has been given to what applicant intends as “a certain area” or “certain areas”. Any area can be considered to be certain areas including all areas.

Regarding claims 1, 2, 3, 5, 9, 12, 17, 20, and 23, no limitation regarding the orientation of the first and second layers has been set forth rendering the claims indefinite. It is unclear whether applicant intends the first layer to be positioned over or under the second layer, and whether the upper or lower surfaces are considered to be the first or second surfaces. For the purposes of examination and in the interest of compact prosecution the examiner interprets the first layer to sit above the second layer, the upper surfaces to be the first surfaces, and the lower surfaces to be the second surfaces. Claims 10, 11, and 13, are rejected as they depend from the above rejected claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 9-11, and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otten et al. (PGPub US 2001/0006713) in view of Jung et al. (US Pat. 6,372,341).

Regarding applicant's claims 1 and 3, Otten discloses an adhesive security tape for detecting unauthorized broaching of a package. The tape is comprised of a thermoplastic film (*considered to be a first film*), a primer layer, a ink layer (*paragraphs 0057*), a second release layer (*considered an adhesive layer because it exhibits adhesion, paragraph 0059*), and a release layer positioned over the upper surface of the film (*paragraphs 0082 - 0088 and figure 1*). Otten does not appear to explicitly disclose a second film. However, Jung discloses a Tamper indicating article for reusable substrates having a carrier layer that may have a highly extensible and substantially inelastic carrier with a layer of pressure-sensitive adhesive (see *component (a)*, *col. 2 line 44 – col. 4 line 28, specifically col. 3 lines 66-67*). It would have been obvious to one of ordinary skill in the art at the time of the invention to replace the bottom adhesive layer of Otten (*figure 1 #16*) with “component (a)” of Jung in order to provide a means for attaching the tape to an article so that it may be removed without damaging its substrate. It is noted that because the carrier layer is extensible but inelastic removing the tape (*which would require stretching*) would distort the tamper pattern alerting that an unauthorized broach had occurred.

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Regarding applicant's claim 2, Otten is silent to an embodiment where the center three layers of primer, ink, and adhesive are reversed in order, so that the primer is applied to the second film instead of the first film. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to reverse these layers so that the ink remains adhered to a substrate in the pattern of the primer layer because one of ordinary skill would recognize a pattern can be produced by stripping away ink in the negative of the pattern you want to remain or ensuring the pattern you want to remain is well adhered to the substrate via the primer. Either arrangement will produce a tamper indicating pattern left behind following peeling of the tape

Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to switch the order of primer, ink and adhesive layers, since it was held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding applicant's claim 4, Otten discloses the separation or failure to occur along the first release layer, below the first film (*paragraph 0090*). Jung discloses that the lower adhesive is selected to provide a bond to the substrate that is stronger than the adhesive strength between components (a) and (b). Therefore the examiner considers the combination to yield a tape where separation occurs above the second film but below the first film as indicated by Jung and Otten respectively. Further, one of ordinary skill in the art at the time of the invention would be able to select adhesives with the proper strength as to be consistent with the tape of Otten, thereby producing a tape with failure occurring between the first and second films.

Regarding applicant's claims 9 and 10, Jung teaches the adhesives in the double coated carrier to be pressure-sensitive adhesives (PSAs), including acrylic PSAs (*col. 2 lines 66 – col. 3 line 12*).

Regarding applicant's claim 11, Otten discloses that the film considered to be the first film may be polyethylene terephthalate (PET) or polyvinyl chloride (PVC) (*paragraph 0018*), and Jung discloses that the film considered to be the second film may be PVC, polypropylene or polyethylene (*col. 3 lines 24-36*).

Regarding applicant's claim 12, Otten teaches a film that may be PET or PVC as does applicant. Since applicant and Otten teach similar materials they would be expected to exhibit similar properties such as tensile strength. Therefore the films of Otten and Jung are considered to have a tensile strength of 5 to 70 N/inch.

Regarding applicant's claim 16, Otten teaches application of a primer layer, first release layer, and a second release layer (*considered to be a failure layer, paragraphs 0024 -0027 and figure 5*) to a thermoplastic film. The next layer Otten teaches to be coated is a pressure sensitive adhesive layer, however that layer may be substituted with a double coated film as shown above. Otten further teaches the film may then have a release coating applied to it (*paragraph 0024*).

Regarding applicant's claim 17, 18, 19, 20, 21, and 22, Otten teaches that a primer layer is only applied over certain areas so that the regions not having primer may form a word such as OPEN or VOID (*paragraph 0053*). Otten does not appear to explicitly teach that the primer can be applied in the negative pattern of a word such as OPEN or VOID. However, it would have been obvious for one of ordinary skill in the art at the time of the invention of

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reverse the application of the primer to achieve the negative image in order to achieve the desired graphic effect. Additionally, the design of the words or graphics is not considered to impart any structural elements to the tape. Messages, symbols, or designs are not considered to be patentably distinguishable from one another as, the court has found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re seid*, 161 F.2d 229, 73 USPQ 431 (CCPA1947).

Next, the ink layer is applied over the surface of the first release layer (*paragraph 0057*), followed by the second release layer (*considered an adhesive layer because it exhibits adhesion, paragraphs 0057-0059*). The double-coated film is applied to the second release layer in place of the pressure-sensitive adhesive layer of Otten as shown above.

Regarding claim 20, the rearrangement of parts has been shown above to be obvious and as such the process of applying the layers in the reverse order starting with the first film is considered to be obvious, because if you reverse the order of the layers, one of ordinary skill in the art would contemplate reversing the coating of the layers as well. Additionally, since the coating process begins with the most strongly adhesive layer one of ordinary skill in the art would have found it obvious to begin coating with that layer from the first film up. Not only is this the logical progression after reversing the order, but it provides an ink layer that is more strongly adhered to the substrate in the desired pattern, which leads to a more durable indication pattern following removal of the upper film.

Regarding applicant's claim 23, Otten discloses a first release layer over the full area of the primer regions and may include the regions free of primer as well. The examiner considers a

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release layer applied over the full area to include all regions including those which may be considered margins (*paragraph 0054*).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otten and Jung further in view of Hudson et al. (PGPub US 2003/0161017).

Otten and Jung teach a tamper evident tape as shown above but do not explicitly disclose perforations in the first film. However, Hudson discloses an optical device for security (*abstract*) with variable perforations (*paragraph 0052*). It would have been obvious for one of ordinary skill in the art at the time of the invention to employ the variable perforations as used in Hudson in order to increase the tapes ability to indicate an unauthorized broaching of a package (*paragraph 0052*).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam C. Krupicka whose telephone number is (571)270-7086. The examiner can normally be reached on Monday - Thursday 7:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Adam C Krupicka/
Examiner, Art Unit 1794

/JENNIFER MCNEIL/
Supervisory Patent Examiner, Art Unit 1794